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| EXAMINER | |
|---|---|
| SANTOS, PATRICK J D | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2161 | |

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/892,676 | CHEN ET AL. | |
| | Examiner | Art Unit | |
| | Patrick J Santos | 2161 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *02 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Specification*

1. Examiner notes amendments to specification regarding trademarks and withdraws previous objection.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 5-7, 12-13, 15, 19-20, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,961,590 issued to Mendez et al. (hereafter Mendez '590).

Claims 1, 12, and 19:

Regarding Claim 1, Mendez '590 discloses: a computer-implemented method for resolving a conflict detected while synchronizing (Mendez '590: Abstract) a first data object in a first store associated with a mobile device (Mendez '590: col. 4, lns. 21-23; col. 4, lns. 36-38) and a second data object in a second store associated with a server (Mendez '590: col. 4, lns. 46-49), comprising:

a) designating at least one property of the first data object as a mergeable property and at least one corresponding property of the second data object as a corresponding mergeable

property (Mendez '590: col. 11, lns. 1-10 – workspace elements correspond do properties, and setting a workspace element to "modified" as to indicate candidacy for merging as per Mendez '590 reads on designating a property as "mergeable");

b) determining if the conflict detected comprises a difference between the at least one mergeable property of the first data object and the at least one corresponding mergeable property of the second data object (Mendez '590: col. 8, lns. 49-54; col. 10, lns. 48-59); and

c) if so, merging the first data object and the second data object to resolve the conflict (Mendez '590: col. 8, lns. 54-60; col. 10, lns. 62-67).

Examiner notes that Claims 12 and 19 are respectively the "computer-readable medium having computer executable instructions" (Mendez '590: col. 20, lns. 52-53) and the "system" (Mendez '590: col. 18, ln. 50) embodiments of Claim 1, and are rejected on the same basis of Claim 1.

Claims 2, 13, and 20:

Regarding Claims 2, 13, and 20, Mendez '590 discloses all the limitations of Claims 1, 12, and 19 respectively (supra). Additionally, Mendez '590 discloses: merging the first data object and the second data object comprises:

- determining a preferred state for each of the at least one mergeable property and corresponding mergeable property that differ (Mendez '590: col. 8, lns. 42-48; col. 2, lns. 65-66 – note option in which merge is an "integrating the modified versions into a single preferred version" which reads on a preferred state of a mergeable property); and

- storing the preferred state in the mergeable property and corresponding mergeable property if an initial state of the mergeable property is different from the preferred state (Mendez '590: col. 8, lns. 42-48; col. 2, lns. 65-66 – note option in which merge is an "integrating the modified versions into a single preferred version"; the integrations is a storage of the preferred state).

Claims 5, 15, and 23:

Regarding Claims 5, 15, and 23, Mendez '590 discloses all the limitations of Claims 1, 12, and 19 respectively (supra). Additionally, Mendez '590 discloses: wherein merging is performed without user-intervention on the mobile device (Mendez '590: col. 2, lns. 65-67).

Claim 6:

Regarding Claim 6, Mendez '590 discloses all the limitations of Claim 1 (supra). Additionally, Mendez '590 discloses: further comprising sending a notification to the mobile device if merging of the first data object and the second data object was performed (Mendez '590: col. 11, lns. 52-56 – note that forwarding reconciled changes reads on a notification).

Claim 7:

Regarding Claim 7, Mendez '590 discloses all the limitations of Claim 6 (supra). Additionally, Mendez '590 discloses: wherein the notification includes an identifier associated with the first data object, a property name associated with the mergeable property in conflicts and a status describing the conflict (Mendez '590: col. 11, lns. 36-40, col. 11, lns. 52-56 – note that forwarding changes reads on identifying the item changed, the property changes, and an indicator as to which version was chosen).

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 3, 11, 14, 21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mendez '590 in view of U.S. Patent No. 6,295,541 issued to Bodnar et al. (hereafter Bodnar '541).

Claims 3, 14, and 21:

Regarding Claims 3, 14, and 21, Mendez '590 discloses all the limitations of Claims 2, 13, and 20 respectively (supra). However, Mendez '590 does not disclose the preferred state is related to a likelihood that vital information would be lost if the preferred state did not replace the initial state when different.

Bodnar '541 discloses the preferred state is related to a likelihood that vital information would be lost if the preferred state did not replace the initial state when different (Bodnar '541: col. 48, lns. 52-54; col. 48, ln. 65 to col. 49, ln. 8; col. 49, lns. 50-59 – note that Bodnar '541 provides for merge rules that provide for user setting of preferences that reflect loss of data).

It would have been obvious for a person having ordinary skill in the art to apply the merge rules of Bodnar '541 to the resolution conflict method and system of Mendez '590. The motivation for the ordinarily skilled artisan to accomplish said application is suggested by Bodnar '541 which discloses application of Bodnar '541 provides a resolution conflict method and system such as Mendez '590, the advantageous ability to handle new and arbitrary datasets and data types (Bodnar '541: col. 3, lns. 54-63).

Claim 11:

Regarding Claim 11, Mendez '590 discloses all the limitations of Claim 1(supra). However, Mendez '590 does not disclose determining if values associated with the at least one mergeable property of the first data object and the at least one corresponding mergeable property of the second data object are the same, and if so, dismissing the conflict.

Bodnar '541 discloses: determining if values associated with the at least one mergeable property of the first data object and the at least one corresponding mergeable property of the second data object are the same, and if so, dismissing the conflict (Bodnar '541: col. 9, lns. 1-17).

It would have been obvious for a person having ordinary skill in the art to apply the merge rules of Bodnar '541 to the resolution conflict method and system of Mendez '590. The motivation for the ordinarily skilled artisan to accomplish said application is on the same basis as Claim 3 (supra).

Claim 24:

Regarding Claim 24, Mendez '590 discloses: a computer-implemented method for synchronizing a first data object and a second data object (Mendez '590: Abstract; col. 4, lns. 21-23; col. 4, lns. 36-38; col. 4, lns. 46-49), comprising:

- detecting a conflict between the first data object and the second data object (Mendez '590: col. 8, lns. 49-54; col. 10, lns. 48-59);
- identifying at least one property of the first data object that is mergeable and at least one corresponding property of the second data object that is mergeable (Mendez '590: col. 11, lns. 1-10 – workspace elements correspond do properties, and setting a workspace

element to "modified" as to indicate candidacy for merging as per Mendez '590 reads on designating a property as "mergeable"); and

- automatically resolving the conflict by merging the first data object and the second data object (Mendez '590: col. 8, lns. 54-60; col. 10, lns. 62-67).

However, Mendez '590 does not explicitly disclose that the automatic resolving of the conflict also forms a single, identical data object in each store.

Bodnar '541 discloses automatic conflict resolution and specifically discloses that the automatic resolving of the conflict also forms a single, identical data object in each store (Bodnar '541: col. 48, lns. 52-54; col. 48, ln. 65 to col. 49, ln. 8; col. 49, lns. 50-59 – note that Bodnar '541 provides for automatic merge rules that reconcile data objects such that different stores will have identical data objects).

It would have been obvious for a person having ordinary skill in the art to apply the merge rules of Bodnar '541 to the resolution conflict method and system of Mendez '590. The motivation for the ordinarily skilled artisan to accomplish said application is on the same basis as Claim 3 (supra).

6. Claims 4 and 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mendez '590 in view of U.S. Patent No. 6,546,417 issued to Baker (hereafter Baker '417) and in further view of Bodnar '541.

Claims 4 and 22:

Regarding Claims 4 and 22, Mendez '590 discloses all the limitations of Claims 2 and 20 (supra). Additionally, Mendez '590 discloses, wherein the first data object and the second data

object comprise an email object (Mendez '590: col. 2, lns. 6-12). However, Mendez '590 does not explicitly disclose that the mergeable property and corresponding mergeable property comprises a read indicator and the preferred state comprises an unread state.

Baker '417 discloses a read indicator (Baker '417: col. 9, ln. 62). However, Baker '417 does not explicitly disclose the preferred state comprises an unread state.

Bodnar '541 discloses Original Priority Resolution, which implies the preferred state comprises an unread state (Bodnar '541: col. 50, ln. 40 to col. 51, ln. 4).

It would have been obvious to a person having ordinary skill in the art to apply the read indicator of Baker '417 to the email system within Mendez '590. The motivation to accomplish said application is suggested by Baker '417 which discloses, providing the advantage of mapping MIME type to icons to a mail system such as that of Mendez '590 (Baker '417: col. 4, lns. 10-20).

It would have been further obvious for a person having ordinary skill in the art to apply the Original Priority Resolution of Bodnar '541 to the Mendez '590 and Baker '417 combination. The motivation for the ordinarily skilled artisan to accomplish said application is suggested by Bodnar '541 which discloses application of Bodnar '541 provides a resolution conflict method and system such as the Mendez '590 and Baker '417 combination, the advantageous ability to handle new and arbitrary datasets and data types (Bodnar '541: col. 3, lns. 54-63).

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mendez '590 in view of Baker '417.

Claim 8:

Regarding Claim 8, Mendez '590 discloses all the limitations of Claim 1 (supra). Additionally, Mendex '590 discloses the first data object and the second data object comprise an email object (Mendez '590: col. 2, lns. 6-12). However, Mendez '590 does not explicitly disclose the at least one mergeable property and corresponding mergeable property comprises a read indicator.

Baker '417 discloses a read indicator (Baker '417: col. 9, ln. 62).

It would have been obvious to a person having ordinary skill in the art to apply the read indicator of Baker '417 to the email system within Mendez '590. The motivation to accomplish said application is suggested by Baker '417 which discloses, providing the advantage of mapping MIME type to icons to a mail system such as that of Mendez '590 (Baker '417: col. 4, lns. 10-20).

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mendez '590 in view of U.S. Patent No. 5,247,438 issued to Subas et al. (hereafter Subas '438).

Claim 9:

Regarding Claim 9, Mendez '590 discloses all the limitations of Claim 1 (supra). Additionally, Mendez '590 discloses the first data object and the second data object comprise an appointment object (Mendez '590: col. 4, lns. 19-20; col. 4, ln. 66). However, Mendez '590 does not explicitly disclose and the at least one mergeable property and corresponding mergeable property comprises a reminder and a reminder time.

Subas '438 discloses a reminder and a reminder time (Subas '438: col. 1, lns. 15-23).

It would have been obvious to a person having ordinary skill in the art to apply the reminder time of Subas '438 to the Mendez '590 invention. The motivation to accomplish said application is suggested by Subas '438 which discloses that reminder time is required to display calendar data in a Gantt chart which provides a particularly advantageous graphical representation of calendar data (Subas '438: col. 1, lns. 52-65).

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mendez '590 and Subas '438, and in view of in view of Bodnar '541.

Claim 10:

Regarding Claim 10, Mendez '590 and Subas '438 in combination disclose all the limitations of Claim 9 (supra). However, Mendez '590 and Subas '438 in combination do not explicitly disclose the conflict is resolved by merging a reminder with an earlier reminder time of the conflicting properties as the value for both properties.

Bodnar '541 discloses Original Priority Resolution, which implies merging a reminder with an earlier reminder time (Bodnar '541: col. 50, ln. 40 to col. 51, ln. 4).

It would have been obvious for a person having ordinary skill in the art to apply the Original Priority Resolution of Bodnar '541 to the Mendez '590 and Subas '438 combination. The motivation for the ordinarily skilled artisan to accomplish said application is suggested by Bodnar '541 which discloses application of Bodnar '541 provides a resolution conflict method and system such as the Mendez '590 and Subas '438 combination, the advantageous ability to handle new and arbitrary datasets and data types (Bodnar '541: col. 3, lns. 54-63).

10. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mendez '590 in view of U.S. Patent No. 5,758,354 issued to Huang et al. (hereafter Huang '354).

Claim 16:

Regarding Claim 16, Mendez '590 discloses all the limitations of Claims 12. Additionally, Mendez '590 discloses: the first data object comprises a set of properties (Mendez '590: col. 10, lns. 3-18 – note a workspace element reads on a property) and merging includes sending the set of properties to the mobile device if an initial state of the mergeable property that differs from the corresponding merged property is different than a preferred state (Mendez '590: col. 11, lns. 52-56; col. 2, lns. 65-66 – note that an initial state differing from a preferred state reads on a conflict which in turn triggers the forwarding of changes as per Mendez '590). However, Mendez '590 does not disclose: sending a subset of the set of properties to the mobile device.

Huang '354 discloses: sending a subset of the set of properties to the mobile device (Huang '354: col. 7, ln. 60 to col. 8, ln. 3).

It would have been obvious for a person having ordinary skill in the art to apply the subset of properties of Huang '354 to the method and system of Mendez '590. The motivation for the ordinarily skilled artisan to accomplish said combination is suggested by Huang '354 which discloses that use of a subset provides for a synchronization architecture that is particularly suited to memory limited devices such as that of the hand held computers of Mendez '590 (Huang '354: col. 8, lns. 3-6).

Claim 17:

Regarding Claim 17, Mendez '590 and Huang '354 in combination disclose all the limitations of Claim 16 (supra). Additionally, Mendez '590 and Huang '354 in combination disclose: the subset includes the mergeable property that differs from the corresponding mergeable property (Huang '354: col. 7, ln. 60 to col. 8, ln. 3 – note that the "relevant changes" of Huang '354 read on the mergeable property i.e. a property that changed thus triggering a synchronization).

11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mendez '590 and Huang '354, in view of Bodnar '541.

Claim 18:

Regarding Claim 18, Mendez '590 and Huang '354 in combination disclose all the limitations of Claim 16 (supra). However, Mendez '590 and Huang '354 in combination do not explicitly disclose: the preferred state is related to a likelihood that vital information would be lost if the preferred state did not replace the initial state when different.

Bodnar '541 discloses the preferred state is related to a likelihood that vital information would be lost if the preferred state did not replace the initial state when different (Bodnar '541: col. 48, lns. 52-54; col. 48, ln. 65 to col. 49, ln. 8; col. 49, lns. 50-59 – note that Bodnar '541 provides for merge rules that provide for user setting of preferences that reflect loss of data).

It would have been obvious for a person having ordinary skill in the art to apply the merge rules of Bodnar '541 to the Mendez '590 and Huang '354 combination. The motivation for the ordinarily skilled artisan to accomplish said application is suggested by Bodnar '541 which discloses application of Bodnar '541 provides a resolution conflict method and system

such as the Mendez '590 and Huang '354 combination, the advantageous ability to handle new and arbitrary datasets and data types (Bodnar '541: col. 3, lns. 54-63).

***Response to Arguments***

12. Applicant's arguments filed December 2, 2004 have been fully considered but they are not persuasive. Applicant's arguments are addressed below:

A. From the perspective of a workspace,
Mendez '590 discloses merging (Amendment: pp. 8-9, Section II).

Applicant argues that since Mendez '590 does not explicitly disclose automated merging at the file level, that Mendez '590 does not disclose conflict resolution. In response Examiner notes that the features upon which applicant relies (i.e., automated merging at the file level) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner interprets Mendez '590 as a reconciler of workspaces. This reads on conflict resolution of data objects.

First, a workspace is a data object. Examiner finds Applicant's claims as currently written to be impermissibly broad since claims use the term "data

object." Examiner notes that a data object is a completely generic term that may apply equally to files or to workspaces or to an arbitrary set of data that is manipulatable by a computer program. Thus, Mendez '590 read from the workspace level, reconciles data objects, i.e. workspaces. In the prior office action, Examiner attempted to point out this distinction in the rejection regarding Claims 1, 12, and 19 in stating:

> ... workspace elements correspond do properties, and setting a workspace element to "modified" as to indicate candidacy for merging as per Mendez '590 reads on designating a property as "mergeable"

Second, a computer program that requests user input in order to reconcile, still reads on resolution of conflict. Applicant further argues that even at the workspace level, files themselves are reconciled, and cites Mendez '590 which states under some circumstances "may include requesting instructions from the user" (Mendez '590: col. 10, lns. 59-67). Examiner points out that even in requesting instructions from the user, Mendez '590 nonetheless discloses a reconciliation of workspaces, which reads on a conflict resolution as recited in the claims as currently written.

Claim 24, which was added in the current amendment acknowledges these issues. Examiner refers to the rejection of Claim 24 under 35 U.S.C. 103(a) over Mendez '590 in view of Bodnar '541 (supra).

B. Mere assertion that prior art may not be modified in a particular manner is insufficient to overcome a 103(a) (Amendment: p. 11, Section III).

Applicant merely states, "Applicants assert that the prior art cannot be modified in the manner suggested in the Office Action." (Amendment: p. 11, lns. 16-17) but does not offer supporting evidence. Thus, Examiner reiterates 103(a) rejections.

In general, Applicant's argument asserting, "that the prior art cannot be modified in the manner suggested in the Office Action." (Amendment: p. 11, lns. 16-17), fails to comply with 37 CFR 1.111(b) because it amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J.D. Santos whose telephone number is 571-272-4028. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patrick J.D. Santos
January 8, 2005

SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
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